

Appl. No. 10/619,656
Docket No. CM2504RQ
Amdt. dated December 10, 2007
Reply to Office Action mailed September 29, 2007
Customer No. 27752

REMARKS

Claim Status

Claims 1-7 are currently under consideration. No additional claims fee is believed to be due.

Claim 1 has been amended to recite that the caliper increase is relative to an uncalendared and unembossed paper web. Support for the amendment is found at page 11, lines 15-19 of the Specification.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 U.S.C. §112

U.S.C. §112, First Paragraph

Claims 1-7 have been rejected under 35 U.S.C. §112, First Paragraph for failing to provide enablement. The Applicants are confused as to the reason for the rejection because the claims simply recite, *inter alia*, steps of a method. The Office Action argues that the specification “does not enable [any person skilled in the art] to make and/or use the invention commensurate with these claims.” (Office Action dated September 27, 2007, p. 2). The Applicants respectfully submit that the process steps involved are described quite clearly throughout the Specification (i.e., stretch embossing is described on p. 6, line 20 through p. 8, line 13; lotion application is described on p. 8, lines 15 through p. 10, line 14; and calendaring is described on p. 10, lines 16 through p. 11, line 6).

In addition, the Applicants respectfully submit that the section of the Specification that the Office Action references simply describes the surprising effects that one observes when the stretch embossing process is combined with the calendaring process. (Specification, p. 11, lines 7-14). Further, the Applicants respectfully submit that exemplary surprising results are described in the same area of the Specification (Specification, p. 11, lines 15-33 – describing improvements and surprising results

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regarding caliper, thickness, wet burst, and dry tensile). Thus, the Applicants are at a loss to understand how the Specification has not properly enabled the claims as presented.

In light of the arguments above, the Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. §112, First Paragraph.

U.S.C. §112, Second Paragraph

Claims 1-7 have been rejected under 35 U.S.C. §112, Second Paragraph for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Specifically, the Office Action argues that Claim 1 is vague because it does not describe how calendaring increases the bulk of the web. The Applicants maintain the arguments *supra*, on the ground that it is a series of process steps that are recited, and exemplary surprising results of the claimed process steps are clearly evidenced on p. 11, lines 15-33 of the Specification.

Regarding the relative basis for increase of caliper, Claim 1 has been amended to recite that the caliper increase is relative to an untreated paper web. As a result of the Amendment, the Applicants respectfully submit that the claim is now proper under 35 U.S.C. §112, Second Paragraph.

In light of the arguments and amendments described above, the Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. §112, Second Paragraph.

Rejection Under 35 U.S.C. §103(a) Over [reference]

Claims 1-7 have been rejected under 35 U.S.C. §103(a) over U.S. Pat. No. 3,414,459 (hereinafter “Wells”) in view of U.S. Pat. No. 5,702,571 (hereinafter “Kamps”) and/or U.S. Pat. No. 5,990,377 (hereinafter “Chen”) and/or U.S. Pat. No. 6,352,700 (hereinafter “Luu”). This rejection is traversed on the ground that Wells in view of Kamps and/or Chen and/or Luu does not make obvious the Applicants’ claimed invention because the cited art fails to provide the required showings from Graham v. John Deere

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Co., 381 U.S. 1, 148 USPQ 459 (1966). The four Graham factors are: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the difference between the claimed invention and the prior art; and (4) objective evidence of nonobviousness.

Claim 1 recites, *inter alia*, that the calendaring step is used to increase a caliper of said multi-ply tissue paper product by at least about 10 percent compared to the caliper of an unembossed and uncalendared paper web. The Applicants respectfully note that Wells discloses using a calendaring step to compress (i.e., decrease the caliper) of the structure. (Wells, Col. 5, lines 39-43). The Applicants further submit that this disclosure in Wells actually teaches away from the Applicants' claimed invention. WMS Gaming Inc. v. International Game Tech., 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). In fact, the Applicants submit that it is improper to modify the Wells reference to make the claimed invention because doing so would improperly modify the Wells invention in such a way that it would no longer function as intended. Tec Air, Inc. v. Denso Manufacturing Michigan, Inc., 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999). Thus, regarding Graham factors (1) and (3), it is clear that the scope of content of the prior art is very different, the Applicants respectfully note that Wells discloses a calendaring step that performs the opposite function of what the Applicants claim, and that Wells contains no disclosure (i.e., has limited scope) that would enable one of skill in the art to make the invention as claimed (i.e., increase caliper). Further, going to Graham factors (2) and (4), the Applicants note that one of skill in the art would normally expect calendaring to decrease the caliper of the roll as is evidenced by the statement in Wells (Col. 5, lines 39-43). Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1453, 221vUSPQ 481 (Fed. Cir. 1984). Thus, one of skill in the art would not think to calendar a paper web to increase caliper, and applicant's invention comprising the steps of embossing, then calendaring yields truly unexpected results. In re Soni, 54 F.3d 746, 34 USPQ2s 1684, 1687 (Fed. Cir. 1995). The Applicants note that Kamps, Luu and/or Chen fail to remedy the deficiencies as Kamps is directed to embossing technology (Kamps, Abstract), Chen is directed to an apertured structure having fibers disposed on the surface (Chen, Abstract), and Luu is directed to lotion technology (Luu, Abstract) and the Office Action has not specified any teachings in Kamps, Luu or Chen that disclose the use of calendaring to *increase* the caliper of a paper web as is claimed.

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Therefore, the Applicants respectfully submit that the invention, as claimed, is nonobvious over the cited art. As a result, the Applicants respectfully request that the rejection of Claims 1-7 under 35 U.S.C. §103(a) be withdrawn.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. §112 and 35 U.S.C. §103(a). Early and favorable action in the case is respectfully requested.

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-7 are respectfully requested.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By


Peter T. Nguyen

Registration No. 58,282
(513) 634-4268

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